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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,249

04/04/2005

Masahiko Terakado

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EXAMINER

MURRAY, JEFFREY H

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

11/17/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SUGHRUE265550@SUGHRUE.COM  
USPTO@SUGHRUE.COM  
PPROCESSING@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,249	<b>Applicant(s)</b> TERAKADO ET AL.	
	<b>Examiner</b> JEFFREY H. MURRAY	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 68 and 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 68-69 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

A supplemental restriction is required under 35 U.S.C. 121 and 372.

This application requires a supplemental restriction. Accompanying this response is a copy of the search report which returned an incomplete search due to the breadth and variety of genus of claim 68. The restriction contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

- I. The compound or composition of the Formula (I-B) wherein Ring B is a carbocyclic ring and Ring D is a five-membered heterocyclic ring which contains at least one nitrogen atom, according to Claims 68 and 69.
- II. The compound or composition of the Formula (I-B) wherein Ring B is a carbocyclic ring and Ring D is a six-membered heterocyclic ring which contains two or more nitrogens, according to Claims 68 and 69.
- III. The compound or composition of the Formula (I-B) wherein Ring B is a carbocyclic ring and Ring D is a six-membered heterocyclic ring which contains only one nitrogen, according to Claims 68 and 69.
- IV. The compound or composition of the Formula (I-B) wherein Ring B is a five-membered heterocyclic ring which contains at least one nitrogen atom and Ring D is a carbocyclic ring, according to Claims 68 and 69.
- V. The compound or composition of the Formula (I-B) wherein Ring B is a five-membered heterocyclic ring which contains at least one nitrogen

atom and Ring D is a five-membered heterocyclic ring which contains at least one nitrogen atom, according to Claims 68 and 69.

- VI. The compound or composition of the Formula (I-B) wherein Ring B is a five-membered heterocyclic ring which contains at least one nitrogen atom and Ring D is a six-membered heterocyclic ring which contains two or more nitrogens, according to Claims 68 and 69.
- VII. The compound or composition of the Formula (I-B) wherein Ring B is a five-membered heterocyclic ring which contains at least one nitrogen atom and Ring D is a six-membered heterocyclic ring which contains only one nitrogen, according to Claims 68 and 69.
- VIII. The compound or composition of the Formula (I-B) wherein Ring B is a five-membered heterocyclic ring which contains at least one nitrogen atom and Ring D is a carbocyclic ring, according to Claims 68 and 69.
- IX. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains two or more nitrogens and Ring D is a five-membered heterocyclic ring which contains at least one nitrogen atom, according to Claims 68 and 69.
- X. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains two or more nitrogen atoms and Ring D is a six-membered heterocyclic ring which contains two or more nitrogens, according to Claims 68 and 69.

- XI. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains two or more nitrogen atoms and Ring D is a six-membered heterocyclic ring which contains only one nitrogen, according to Claims 68 and 69.
- XII. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains two or more nitrogen atoms and Ring D is a carbocyclic ring, according to Claims 68 and 69.
- XIII. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains only one nitrogen atom and Ring D is a five-membered heterocyclic ring which contains at least one nitrogen atom, according to Claims 68 and 69.
- XIV. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains only one nitrogen atom and Ring D is a six-membered heterocyclic ring which contains two or more nitrogens, according to Claims 68 and 69.
- XV. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains only one nitrogen atom and Ring D is a six-membered heterocyclic ring which contains only one nitrogen atom, according to Claims 68 and 69.
- XVI. The compound or composition of the Formula (I-B) wherein Ring B is a six-membered heterocyclic ring which contains only one nitrogen atom and Ring D is a carbocyclic ring, according to Claims 68 and 69.

The technical feature linking the claims is the compound or composition of claim 68. However the claims do not identify any particular structure. Therefore the only discernable structure from Formula (I-B) is the propyl hydroxy group located in the center of formula (I-B), as all the remaining portions of the formula are variables. It is well known in the chemical arts that there are literally tens of thousands of compounds which contain a propyl hydroxy group. Therefore, the compound lacks a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the art. Accordingly, Groups I-XVI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is 571-272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey H Murray/  
Examiner, Art Unit 1624

**/James O. Wilson/  
Supervisory Patent Examiner, Art Unit 1624**